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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,387	06/04/2002	Alessio Casati	Casati 2-3-3-	9243
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Lucent Technologies Inc 101 Crawfords Corner Road Holmdel, NJ 07733-3030			EXAMINER CHOU, ALBERT T	
			ART UNIT 2616	PAPER NUMBER

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/030,387

Applicant(s)

CASATI ET AL.

Examiner

Albert T. Chou

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-12 is/are rejected.
- 7) ☒ Claim(s) 2 and 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention, Telecommunications System, is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Objections***

2. Claims 1, 6 and 7 are objected to because of the following informalities:

Claims 1 and 7 are objected to because they include reference characters, which are not enclosed within parentheses (e.g. UMTS, MSISDN, VoIP, PDP, GGSN, IMSI, SIP, etc.). Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

Claim 6 includes all limitations recited in claim 4 and is apparently duplicated from claim 5.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-6 and 8-12 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,611,516 to Pirkola et al. (hereinafter "Pirkola").

Regarding claims 1 and 8, Pirkola teaches a telecommunication system and a method **[Fig. 2; A system includes a cellular network/GSM 260, a MIPTN 202 and a PSTN 240; col. 5, lines 64-67]** including a mobile station **[Fig. 2, MS Terminal in the cellular network; col. 6, lines 38-40]**, having a Mobile Subscriber Integrated Services Digital Network (MSISDN) number associated with the station or its user **[Fig. 2; MS has been assigned one MSISDN number in E.164 format; col. 8, lines 17-19]**, and means for enabling the mobile station to receive Voice-over Internet Protocol (VoIP) calls **[Figs. 2 & 14; MS roaming to Mobile IP-telephony Network MIPTN 202]** established when dynamic Internet Protocol IP addressing is used **[Figs. 2 & 14; Gateway Function 210 makes an address translation based on mapping between**

Art Unit: 2616

**subscriber's MSISDN & IMSI and dynamic mapping between IMSI & IP address; col. 22, lines 32-43]** and the mobile station is not in an active Packet Data Protocol PDP context while roaming away from a home network **[Figs. 2 & 14; MS Terminal, a cellular network subscriber, roaming in MIPTN 202]**. The telecommunication system and the method comprise:

means for informing a serving Gateway GPRS Serving Node (GGSN) **[Fig. 2, Gateway Function 210 (in conjunction with MIPTN Visited Function 206); Fig. 14, Steps 1-9; col. 21, lines 10-67, col. 22, lines 1-15]** of the roaming network **[Figs. 2 & 14; MS Terminal, a cellular network subscriber, has roamed to MIPTN; col. 20, lines 60-62]** of the International Mobile Subscriber Identity (IMSI) of the called mobile station **[Figs. 2 & 14; Fig. 2; MS has been assigned one MSISDN number in E.164 format; col. 8, lines 17-19]** and

means for enabling a serving VoIP call control server **[Figs. 2 & 14, Gateway Function 210/210A]** to map a called MSISDN number to the IMSI number **[Fig. 14, steps 1-3 & 12-13; Gateway Function 210/211, in conjunction with the cellular Home Function 266, makes an address translation based on mapping from subscriber's MSISDN to IMSI; col. 21, 10-40]**.

Regarding claims 4 and 9, Pirkola teaches that the system and the method include a stored mapping table which contains a mapping of the MSISDN number of the mobile station to its IMSI number **[Fig. 8, steps 2 & 3, the mobile station's IMSI in the MIPTN 202 points to Gateway Function 210 and the number of the Gateway**

Art Unit: 2616

**Function 210 is provided with an MSISDN number in E.164 format; col. 15, lines 32-34 & 52-65]. The table can be accessed by the home VoIP call control server [Figs. 2 & 8, HLR 264] for passing the IMSI number to the serving VoIP call control server [Fig. 8 step 4, HLR sends a message to the Gateway Function 210, providing the subscriber's IMSI and profile maintained in the HLR 264; col. 15, lines 66-67, col. 16, 1-4; Fig. 14, step 3; Home Function 266 sends a roaming number request to the Gateway function 210 providing called subscriber's IMSI; col. 21, lines 36-38].**

Regarding claims 5 and 6, Pirkola teaches the system includes means for providing an enhanced terminal registration message so that, upon registration **[Fig. 8; steps 1-3; col. 15, lines 19-65]**, a mobile station informs the serving VoIP call control server of its IMSI number **[Fig. 8; steps 1-2; MS sends an update location message including its IMSI to the serving MIPTN Visited Function 206. In this case, the MS's IMSI points to the Gateway Function 210; col. 15, lines 20-22 & 33-34].**

Regarding claim 10, Pirkola teaches the home VoIP call control server passes the IMSI number to the serving VoIP call control server **[Fig. 14, step 3; Home Function 266 sends a roaming number request to the Gateway function 210 providing called subscriber's IMSI; col. 21, lines 36-38].**

Regarding claim 11, Pirkola teaches when the mobile station registers with the roaming network, it informs the serving VoIP call control server with its IMSI number

Art Unit: 2616

**[Fig. 8; steps 1-2; MS sends an update location message including its IMSI to the serving MIPTN Visited Function 206. In this case, the MS's IMSI points to the Gateway Function 210; col. 15, lines 20-22 & 33-34].**

Regarding claim 12, Pirkola teaches the IMSI number of the called party is passed from home VoIP call control server to serving VoIP call control server in the one or more call setup messages **[Fig. 14, step 3; Home Function 266 sends a roaming number request to the Gateway function 210 providing called subscriber's IMSI; col. 21, lines 36-38; Steps 4-9, the complete call setup procedure; col. 21, lines 46-67, col. 22, lines 1-14].**

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,611,516 to Pirkola et al. (hereinafter "Pirkola"), in view of US Patent No. 6,907,431 to Sayers et al. (hereinafter "Sayers").

Regarding claim 7, Pirkola teaches all limitations recited in the parent claim of claim 7. Pirkola also teaches that an H.323 terminal may register with or communicate with MIPTN visited Function 208 **[Fig. 2; col. 6, lines 51-55]**.

Pirkola does not expressly teach the VoIP call control server is an H.323 gatekeeper or a Session Initiation Protocol (SIP) proxy/server.

Sayers teaches an H.323 gatekeeper **[Fig. 4, Gatekeeper 41; col. 11, lines 12-13]** to provide the functions necessary to control the terminals with the H.323 domain **[col. 11, lines 12-18]**, and an H.323 Gateway **[Fig. 4, Gateway 42; col. 11, lines 45-46]**, which is part of VoIP call control operation, to provide line interface and transcoding functions that allow the voice and data traffic to be sent to existing networks **[col. 11, lines 45-49]**.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the H.323 gatekeeper and/or H.323 gateway functions, as taught by Sayers, into Pirkola's Gateway Functions 210 since Pirkola's invention is already able to support the H.323 terminal in MIPTN Visited Function 208.

The motivation for combining the reference teachings would be to be able to support the widely deployed H.232 terminal devices in the MIPTN VoIP network.

#### ***Allowable Subject Matter***

5. Claims 2 and 3 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent No. 6,690,769 to Turunen et al. disclose "Method And System For Bearer Management In A Third Generation Mobile Telecommunications System"
- US Patent No. 6,104,929 to Josse et al. disclose "Data Packet Radio Service With Enhanced Mobility Enhancement"
- US Patent Publication No. 2002/0049059 A1 by Soininen et al. disclose "IP Routing Optimization In An Access Network"
- US Patent Publication No. 2001/0050908 A1 by Verkama discloses "Mechanism For Network Initiated-Information Transfer"

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert T. Chou whose telephone number is 571-272-6045. The examiner can normally be reached on 8:30 - 17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

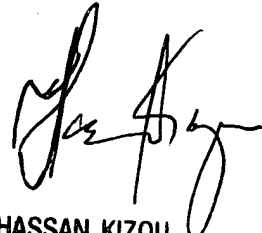
Art Unit: 2616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Albert T. Chou

June 5, 2006

Ac



HASSAN KIZOU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600